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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,536	02/10/2004	James J. Rudnick	760-84 CON 4	6703

23869 7590 12/26/2007

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EXAMINER	
SCHILLINGER, ANN M	

ART UNIT	PAPER NUMBER
3774	

MAIL DATE	DELIVERY MODE
12/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/775,536	RUDNICK ET AL.	
	Examiner	Art Unit	
	Ann Schillinger	3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 61-72 have been accepted by the Applicant to be re-numbered as 26-37, stated in the after non-final amendment filed on 9/13/2007.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., in re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); in re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); in re Van Omum, 686 F.2d 93.7, 214 USPQ 761 (CCPA 1982) in re Vogel 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA .1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10,18,26,29,32,72,81 of U.S. Patent No. 6319277; and claims 26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims land10 of U.S. Patent No. 5575816. Although the conflicting claims are not identical, they are not patentably distinct from each other because newly presented independent claim 26 is a broader species than the narrower species of claim 1 in US Patent 6319277. Although the functional language of the nested stent is not clearly defined in the claims as providing means for minimizing tissue ingrowth, the configuration of the claimed stent in the

parent and the instant application do not differ and therefor would provide the function of minimizing (i.e. inhibiting) tissue ingrowth.

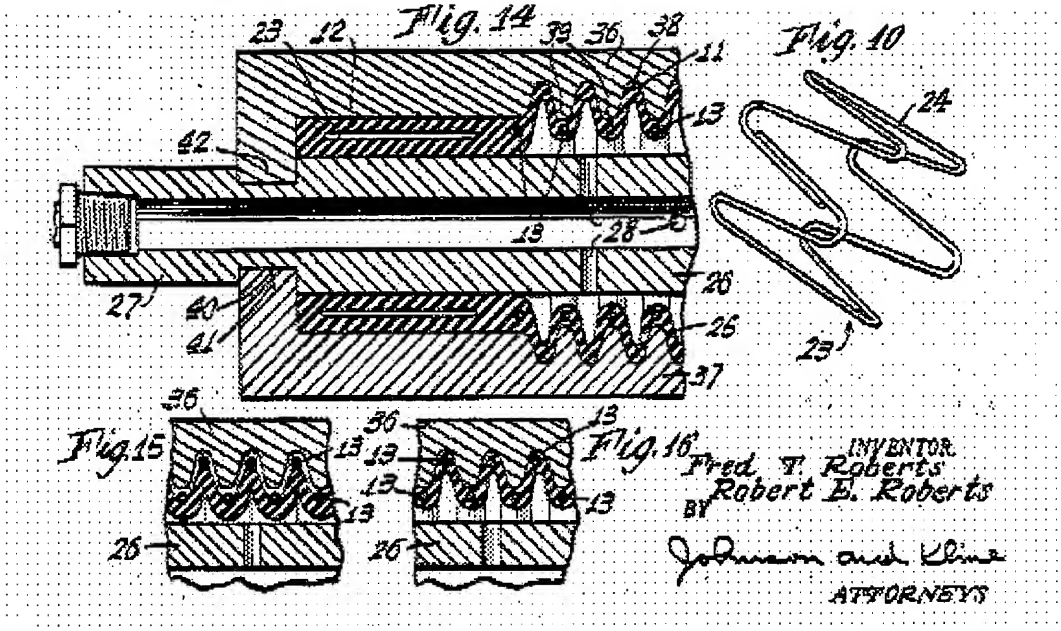
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 26, 30, 31, 33, and 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roberts, et al [2780274]. Roberts, et al discloses a tubular device having wire defining a plurality of nested wire waves and a non-porous cover extending along the length of the tubular device. While the device is not intended for intraluminal applications, the resulting structure would provide the function of not allowing free tissue ingrowth through the cover and through the wire. See column 3, lines 30+.



Claims 26-28, 30, 31, 33, 34, and 37 are rejected under 35 U.S.C. 102(e) as anticipated by An et al. [5545211]. An et al. discloses the following of claim 26: an intraluminal device comprising: an elongate tubular stent (C) formed of wire defining a plurality of nested wire waves (9, 10, 13) wherein said nested wire waves minimize inhibit tissue ingrowth between the waves; and a cover (14) extending along the length of the stent further minimizing inhibits tissue ingrowth therethrough.

An et al. discloses the limitations of claims 27 and 28 in col. 3, lines 20-25 and as shown in Figure 5.

An et al. discloses the limitations of claims 30-32 and 35 in col. 3, line 65 through col. 4, line 5.

An et al. discloses the limitations of claims 33 and 34 as shown in Figure 5.

An et al. discloses the following of claims 37: an intraluminal device of claim 26 wherein said wire includes a single continuous, helically wound wire (8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 29 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over An et al. in view of Dereume [5653747]. An et al. discloses the invention substantially as claimed, however, An et al. does not disclose a porous cover on the device. Dereume teaches a luminal graft with a porous cover in col. 4, lines 12-19 for the purpose of giving the cover greater flexibility. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a porous cover in order to give the cover greater flexibility.

Response to Arguments

In view of the amendment to claim 26 submitted on 9/27/2007, the 35 U.S.C. 112, first paragraph rejection has been withdrawn.

Please note that the Applicant filed to provide information directed to the language in the original specification that supports the newly presented claims, 26-37.

Applicant's arguments filed 9/27/2007, regarding the Roberts rejection, have been fully considered but they are not persuasive. The Applicant contends that the Roberts reference is not

in an analogous art area, and therefore does not qualify as prior art to the claimed invention. It has been held that the determination that a reference is from non-analogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood,* 202 USPQ 171, 174. In this case, both the Applicant and the Roberts reference seek to create devices that have compressive strength and are still flexible. Both devices use the claimed wire structure to accomplish these goals (see Applicant's specification, page 2; and Roberts, col. 1).

Roberts teaches a plurality of nested wire waves in elements 23 and/or 13.

The Applicant further contends that "inhibits" implies that some ingrowth of the tissue is possible. However, "inhibits" taken according to its dictionary definition means, "to prohibit; forbid" (inhibit. Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. http://dictionary.reference.com/browse/inhibit (accessed: December 12, 2007)). This definition indicates that inhibit may allow for no tissue ingrowth through the device. In addition, Applicant's claim 30 calls for a solid covering which would not allow any tissue growth through.

Applicant's arguments with respect to claims 26-37 and the Lau et al. have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Schillinger whose telephone number is (571) 272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Schillinger
December 12, 2007

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